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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *14 March 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,7-11,18-27* is/are pending in the application.

    4a) Of the above claim(s) *2-6,12-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7-11,18-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   The examiner for this application has changed. Please indicate Examiner Hai

Tran as the examiner of record in all future correspondences.

2.   This is the communication in response to Applicant's Request for Continued

Examination and Remarks filed on March 14, 2007 for its application case 10/015,250,

titled: "Methods And Systems For Communicating With Customers".

3.   Claims 1, 7-11 and 18-27 are pending in this application.

Continued Examination Under 37 CFR 1.114

4.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March

14, 2007 has been entered.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 25-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7.   Examiner notes that Applicant has amended the claims to recite the following functionality, "positioning the non-billing information at a location relative to the location of the billing information in the customized communication that varies from the location relative to the billing information in at least one prior customized communication to the customer, so that the billing information is not always in the same area of the customized communication."

8.   The only support for this step in Applicant's Specification resides in the Summary of the Invention section. Specifically, page 2, paragraph 0007 includes the following language, "the billing information is not always located in the same area of the newsletter." As this is the only support for the newly added limitation, Examiner asserts that one of ordinary skill at the time of the invention would not have reasonably concluded from Applicant's Specification that Applicant was in possession of the claimed method.

9.   Examiner notes that in order to accomplish the claimed limitation (i.e. vary the location of the billing information "so that the billing information is not always in the same area of the customized communication") the present invention must store data with respect to the positioning of all information in each customer's bill.   In other words, in order to ensure that the invention varies the location of the information "relative to the billing information in the at least prior customized communication . . . so that the billing information is not always in the same area of the customized communication," the invention must store information on where information was placed in "at least prior customized communication."

10.   There is simply nothing in the Specification that indicates that the disclosed system stores or saves a layout as presented to the user. As such there is no way for the system to be sure that a current bill varies from a prior bill. It is the Examiner position that Applicant was simply not in possession of such a system at the time of the present invention.

11.   Examiner notes that Applicant has argued in the response filed 3/14/07 that an alternative approach to achieve the argued claim limitation would be to "vary the location of the billing information, relative to the non-billing information, in a random manner when preparing each bill."

12.   Examiner notes that even this approach is not supported by the Applicant's specification and therefore Examiner does not believe that Applicant was in possession of such an invention at the time of the filing.   Examiner once again points out that

except for one throwaway sentence found the summary of the invention section there is

nothing in the Applicant's specification which describes this limitation. Specifically,

there is nothing in the specification which describes this newly argued random

generator used to place the non-billing information in various position from one

communication to the next.

13.   Therefore, even under this alternative interpretation, the rejection under 112 1st

paragraph is maintained.

14.   Examiner would also like to assert that under this new interpretation (i.e. random

placement of the non-billing information) Applicant's disclosure, when filed, did not

contained sufficient information regarding the subject matter of the claims as to enable

one skilled in the pertinent art to make and use the claimed invention. In fact, it is the

Examiner's position that the experimentation needed to practice the invention is undue

and/or unreasonable.

15.   In taking the position that Applicant's specification does not enable the claimed

invention, the Examiner will address the following factors:

A) **The breadth of the claims**: Examiner notes that per Applicant's arguments

the scope of the argued limitation is a random generator used to ensure the

placement of non-billing information from one communication to the next is

varied.

B) **The nature of the invention**: Examiner notes that the nature of Applicant's

invention is the combining of non-billing information with billing information

to form a communication. The inventive concept (as evidenced by the vast

majority of the specification) is not the specific (or varied) placement of the

non-billing information within the communication. Rather, it is the

Examiner's position that Applicant is retroactively reconstructing the

specification to find support for a limitation that was not part of Applicant's

original inventive concept.

C) **The state of the prior art:** Examiner notes that (as evidenced by the prior

art of record) at the time of the invention combining non-billing information

with billing information was known in the art (see Munsil et al.). Specifically,

as pointed out in the rejection section of this and previous Office actions,

users of Munsil are able to utilize a report generator to place non-billing

information in any place they desire (see Munsil et al. column 2; lines 20-27

and column 5; lines 30-52 and column 12; lines 55-60).

D) **The level of one of ordinary skill**: Based on the applicant's specification

the pertinent art is billing and advertisement. Examiner asserts that a

person with skill in this art would not reasonable know how to create a

random generator to ensure that non-billing information varies from one

communication to the next.

E) **The level of predictability in the art**: Examiner notes that the predictability

or lack thereof in the art refers to the ability of one skilled in the art to

extrapolate the disclosed or known results to the claimed invention. If one

skilled in the art can readily anticipate the effect of a change within the

subject matter to which the claimed invention pertains, then there is predictability in the art. On the other hand, if one skilled in the art cannot readily anticipate the effect of a change within the subject matter to which that claimed invention pertains, then there is lack of predictability in the art. Accordingly, what is known in the art provides evidence as to the question of predictability.

Examiner believes based on this standard, that the art is in fact unpredictable because one of ordinary skill in the art at the time of the present invention could not reasonably anticipate the effect of change within the subject matter to which the claimed invention pertains. As has been argued by the Examiner in this and previous Office actions, Applicant states in the specification (paragraph 7) that the varying the placement of non-billing information "**may** induce a customer to reading non-billing information." Examiner asserts that one of ordinary skill could not reasonable know the level of inducement (change) brought on by varying the placement of non-billing information. As such the art is found to be unpredictable.

F) **The amount of direction provided by the inventor**: As pointed out countless times the inventor has provided little to no direction with respect to this limitation.

G) **The existence of working examples**: Examiner notes that save the one sentence in the summary of the invention section, Applicant does not

disclose a working example of the claimed invention, nor has the Examiner been provided with a working example during prosecution.

H) **The quantity of experimentation needed to make or use the invention based on the content of the disclosure:** as noted by the Examiner above it is believed that the quantity of examination required by one of ordinary skill to create a random generator to ensure that billing information is changed from one communication to the next would be great and undue.

16.   A review of the evidence with respect to the above factors leads the Examiner to conclude that the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

17.   Finally, Examiner points out that Applicant's specification is drawn to a system and method for combining customized non-billing information with billing information. The placement of the information on the bill was not part of Applicant's inventive concept at the time of filing. It is the Examiner's belief that the Applicant is retroactively reconstructing the specification to find support for a limitation that Applicant was not in possession of nor was part of the originally filed inventive concept.

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

19.   Claims 1, 7-11 and 18-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Munsil et al. in view of "How to remove your name from junk mail,

phone-solicitation lists" by Denise Nelsen (hereinafter Nelsen).

20.   Munsil et al. teaches a billing method comprising obtaining billing information for

a customer from a database comprising customer profiles, customer billing information

and non-billing information profiles and obtaining non-billing information pertinent to the

customer ((column 3; lines 18-21) & (column 3; line 55- column 4; line 31 and Figure

1)).

21.   Examiner notes that the bill production processor system 15 extracts (obtains)

from a customer database or databases 14, the customer data to be printed on the

billing statements (column 4; lines22-24). The customer data extracted includes

account status information, customer address information, account balance information,

legal notices, promotional notices and other data for each of the customers to be billed

(column 4; lines 28-31).   Examiner notes that account status information, customer

address information and account balance information represent billing information.

Additionally, legal notices and promotional notices represent non-billing information.

22.   Munsil et al. teaches combining the billing information and non-billing information

to create a customized communication (e.g. column 11; lines 34-56 and column 12;

lines 1-24).

23.   Examiner notes that Munsil et al. teaches messages that are includes on a billing

statement and these messages represent non-billing information pertinent to a

customer. Further a billing statement with a message represents Applicants customized

communication.

24.   Munsil et al. teaches conveying said customized communication to the customer

(column 1; lines 25-33). Examiner notes that Munsil et al. teaches that sending billing

statements is old and well known, thus Munsil et al. anticipates that the customized

billing statements generated by the method and system of Munsil et al. will be received

by the customer (conveyed to the customer).

25.   Munsil et al. teaches a report editor which allows a report designer to use a

palette of tools to customize where data is to appear on a report or bill. The report

designer will decide how the report/bill will generally appear, and using tools, create a

graphical layout of where textual information will physically appear on the report/bill

(column 2; lines 20-27).   Examiner notes that this includes the customized placement of

both billing information (column 5; lines 30-52) and non-billing information (column 12;

lines 55-60).

26.   However, while Munsil et al. teaches that a report editor can customize the layout

of report any way he/she chooses, Munsil et al. does not specifically teach positioning

the non-billing information between a customer identifier located at the beginning of the

communication and a billing amount located at the end of the communication.

27.   Examiner notes, based on Applicant's specification the specific positioning of the

non-billing information (i.e. between a customer identifier at the beginning and a billing

amount at the end of the communication) is not a critical feature of the present

invention. In fact Applicant's only mention of the placement of the non-billing

information is found on page 2; lines 17-20: "in one embodiment, the billing information

is not always located in the same area of the newsletter. This *may* induce a customer

to read non-billing information while searching for the billing information, particularly

since the information is tailored to the customer." Examiner notes that this indicates

that dynamic placement of the non-billing information *may* induce a customer to read

the information. This statement makes clear that the specific placement of non-billing

information holds no functional importance (as it's as likely that the dynamic placement

may not induces a customer to read the non-billing information) nor does it produce an

unexpected or distinct result.   Moreover, it appears that placing the ad anywhere within

the bill will perform equally well, as placement may or may not induce a customer to

read the information.

28.   As Applicant fails to demonstrate the criticality of the specific limitation, (i.e.

placement of non-billing information between a customer identifier at the beginning and

a billing amount at the end of the communication) Examiner finds the limitation to be an

aesthetic design choice (see MPEP 2144 and 2144.04 I). Accordingly, it would have

been obvious to a person of ordinary skill in the art at the time the invention was made

to modify the teaching of Munsil et al. to include the specific placement of message data (non-billing information) between a customer identifier at the beginning of the report/bill (communication) and the billing amount at the end.

29.   Examiner finds support for the motivation to modify Munsil et al. in a court based ruling stating that matter relating to ornamentation only cannot be relied upon to patentably distinguish the claimed invention from the prior art (In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)). Further Examiner notes that legal precedent can provide the rationale supporting obviousness (MPEP 2144).

30.   Munsil further does not teach wherein the customer can opt not to receive any non-billing information.

31.   Nelsen teaches that it is old and well known in the art for consumers to not want to receive direct marketing solicitations. Nelsen further teaches the ability to not receive these solicitations by requesting not to receive them and being placed on a list. One of ordinary skill in the art at the time of the present invention would recognize that such a list is valuable in order to satisfy the references of those customers who wish be to exposed to as few advertisements as possible in their daily lives.

32.   It would have been obvious to one of ordinary skill in the art to modify the teachings Munsil to include a list of consumers who wish to not receive non-billing information as taught by Nelsen. One of ordinary skill in the art would have been motivated to make such a modification in order to satisfy the preferences of those customers who wish be to exposed to as few advertisements as possible in their daily lives.

33.   Examiner notes that the analysis provided above for the rejection of method claim 1 above, also applies to system claim 10. In addition, Examiner notes that the database(s) of Munsil et al. are relational (column 5; lines 44-45).

34.   Munsil et al. teaches creating a set of classifications that correlate to customer traits, assigning applicable classification from that set of classifications to customers and recording the applicable classifications in respective customer profiles (claim 4). Examiner notes that Applicant discloses by way of an example (page 4; lines 13-15 of the Specification) that classifications may include characteristics about a customer, such as zip code in which the customer lives. Using this as an example, Examiner asserts that Munsil et al. teaches creating, assigning and recording a customer's zip code in a customer profile database (column 5; lines 44-52 and column 12; lines 44-46).

35.   Munsil et al. teaches assigning applicable classifications to selected non-billing information, recording classifications in respective non-billing information profiles database (claim 4)(column 12; lines 2-24 and 40-42). Examiner notes that billing criteria represents applicable classifications. Further the act of billing personnel using a graphical user interface to define the billing criteria for a particular message represents assigning applicable classifications to selected non-billing information. Examiner asserts that once billing criteria (applicable classifications) are defined by the billing personnel they are saved. Examiner notes in order for the bill run to qualify each message against stored information for each customer, the billing criteria must also be stored.

36.   Munsil et al. teaches wherein said customized communication comprises a
newsletter (claims 7 and 18) (column 11;lines 45-55). Examiner notes that a newsletter
is defined as a printed report giving news or information of interest to a special group
(Webster's II New Riverside Dictionary). Therefore, providing on a bill for HBO
subscribers (a special group) with a message with the promotion "Free Cinemax in the
month of December for all HBO subscribers. Happy Holidays!" (news or information)
represents a providing newsletter.

37.   Munsil et al. teaches providing printed material to said customer via a delivery
system (claim 8) and a printer in communication with computer system wherein said
printer is capable of printing newsletter (claim 19) (column 1; lines 26-27; column 4;
lines50-51 and Figure 1).

38.   Examiner once again notes that Munsil et al.'s teaching that customer's receiving
billing statements anticipates that the customized billing statements of Munsil et al. are
received by the customer.

39.   Munsil et al. teaches a server connected to a network for communicating with a
terminal connected to the network (claim 11) (column 4; lines 1-5 and Figure 1).
Examiner notes that the customer management system comprises a user terminal for a
user to interact with the report editor and report generator feature.

40.   Munsil et al. teaches a set of classifications correlated to customer traits (claim
12) (column 12; lines 15-24). Examiner notes that billing criteria represents
classifications. Further it is recognized that these billing criteria (classifications) are

correlated to customer traits, for example indicating if a customer subscribes to HBO or lives in a particular tax area.

41.   Munsil et al. teaches wherein applicable classifications are assigned to customers and non-billing information (claim 13) (column 12; lines 15-24). Examiner once again asserts that billing criteria represents classifications. And notes that the billing criteria is assigned to the messages (non-billing information) and are matched with identical criteria (classifications) already assigned to each customer in the customer table (e.g. HBO subscriber, tax area).

42.   Munsil et al. further teaches wherein instructions for assigning applicable classifications to customers and non-billing information (claim 15) (column 12; lines 15-24). Examiner notes that the standard logic used represents the instruction for classifying the customer and the message (non-billing information).

43.   Munsil et al. teaches wherein obtaining non-billing information pertaining to the customer comprises selecting non-billing information related to the customer from a non-billing information profile according to a set of classifications stored in the non-billing information profile that is identical to a set of classifications stored in a customer profile corresponding to the customer (claim 21) (column 12; lines 1-24 and 40-42).

44.   Examiner notes that billing criteria of Munsil et al. represents Applicant's classifications of non-billing information. As such, the messages (non-billing information) are qualified (selected) based on a set of classifications (billing criteria) that are identical to a set of classification stored in a customer profile. Examiner notes the example on column 12; lines17-20 where the billing criteria (classification stored in non-

billing information profile) is franchise tax area 8010. When this billing criteria matches

the identical classification found in the customer table the message is deemed pertinent

to that customer.

45.   Munsil et al. teaches a customer table, wherein said customer table comprises

customer information, unique customer identifiers and classifications assigned to

customers (claim 22) (column 5; lines 44-52). Examiner once again points to

Applicant's Specification page 4; lines 13-15 that states, "classifications may include

characteristics about the customer, such as zip code in which the customer lives."

Examiner notes that since customer database of Munsil et al. contains zip code

information, then the database contains classifications assigned to the customers.

46.   Munsil et al. makes obvious a billing information table, wherein said billing

information table comprises unique customer identifiers and customer billing information

and has a relationship to said customer table based on said unique customer identifiers

(claim 22)(column 5; lines 44-52).

47.   Examiner notes column 5; lines 44-52 teaches as well known in the art relational

databases organized in a plurality of tables with relations between the tables. Further

the section seems to indicate maintaining billing information in one customer table

rather than containing a separate billing table with a relationship between the two

tables. As such Munsil et al. fails to teach a specific billing information database.

However, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to modify the relational database structure to include a separate

billing table with billing information and a relationship to the customer table in order to save disk space.

48.   Munsil et al. teaches a non-billing information table, wherein said non-billing information table comprises non-billing information and classifications assigned to said non-billing information and has a relationship to said customer table based on classifications (column 12; lines 2-24 and 40-42). Examiner notes that billing criteria represents classifications assigned to non-billing information. Further, once billing criteria (assigned classifications) are defined by the billing personnel they are saved. Examiner notes in order for the bill run to qualify each message against stored information for each customer, the billing criteria must be stored in the computer. Examiner notes that the storage of the billing criteria associated with messages represents a non-billing information table with non-billing information (messages) and classifications (billing criteria) assigned to the non-billing information (messages). Additionally, the step of qualifying messages (non-billing information) against stored customer information represents a relationship between the messages (non-billing information) and the stored customer data (customer table).

49.   Munsil et al. teaches a report that combines billing information for a customer with non-billing information that possess an assigned classification matching an assigned classification of said customer, to create customized communication for customer (e.g. column 2; lines 4-8).

50.   Munsil et al. teaches wherein non-billing information pertinent to the customer comprises news information pertinent to the geographic region in which the customer

resides (claims 23 and 24) (column 12; lines 44-49). Examiner notes the information about imminent repairs represents news. Additionally, qualifying a message based on a users zip code relates to information pertinent to a geographical region in which a customer resides.

51.   Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munsil et al. in view of Kovac as applied to the claims above, and further in view of Daniels Jr. et al.

52.   Munsil et al. teaches that a user can specify that instead of printing the information in a report it can be drawn in a window on a computer screen, or written to a file on a disc, which can be accessed at a later time without having to go back to the database (column 2; lines 55-61).

53.   Munsil et al. does not teach conveying customized communication to customer electronically (claims 9 and 20).

54.   Daniels Jr. et al. teaches adding the capabilities of electronic mail delivery to existing mass mailing systems (column 1; lines 60-62). In particular the system separates documents into a physical delivery print stream and an electronic delivery print stream based on delivery preferences of the user (column 1; line 65 – column 2; line 2). Examiner notes that the print stream data sent is associated with a company's existing architecture (column 3; lines 37-41). Examiner notes that this is done in order to reduce the amount of paper associated with mass mailings.

55.   It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the printing information stored on a disk of Munsil et al.

by sending it to the print stream separator for electronic delivery as taught by Daniels Jr.

et al. One of ordinary skill would have been motivated to modify the references in order

to reduce the amount of paper used with the mass mailing system of Munsil et al.

Response to Arguments

56.   Applicant's arguments for claims 1, 7-11 and 18-27 filed on March 14, 2007 have

been fully considered but they are not persuasive.

57.   Examiner begins by referencing the "Response to Arguments" section presented

in the Office action mailed 9/26/06.

58.   Further, with respect to Applicant's traversal of the rejection of the claims under

112 1st paragraph, Examiner has addressed this point in the analysis above and

believes the record is clear with respect to this issue.

59.   Regarding Applicant's arguments with respect to "(a) position the non-billing

information between a customer identifier located at the beginning of a communication

and billing amount located at the end of the communication;" Applicant asserts that

functional significance for this limitation can be found in the Specification within

paragraph 7. Examiner notes that the claimed limitation amounts to a static placement

of non-billing information within a communication while applicant's functional support is

derived from either i) including the non-billing info with the billing information or ii)

locating in the billing information is different areas.   Nowhere in Applicant's specification

is there any mention that the specific placement of the non-billing information between

the customer identifier at the beginning and the billing amount at the bottom provides

any function. There is simply no evidence or support for such a claim and as such the

Examiner maintains the position that the specific placement of the non-billing

information within the communication is an aesthetic design choice.

60.   Regarding Applicant's arguments with respect to "(b) the customer can opt not to

receive any non-billing information." Applicant asserts that Nelson does not teach or

suggest "given the customer an option not receive any non-billing information ...". The

Examiner respectfully disagrees. The Examiner notes that the teaching of Nelsen

clearly shows that the customer always has an option not to receive non-billing

information.

61.   The Applicant further argues that combining Nelsen with Munsil would give a

customer the option to terminate Munsil's bill production.   Examiner disagrees and

reminds Applicant that the focus here is: would one of ordinary skill in the art at the time

of the present invention, after considering the evidence provided by Munsil and Nelsen,

reasonably contemplate the claimed invention?   Examiner believes the answer is yes.

62.   Munsil teaches combining billing information with advertisements (non-billing

information) to create a customized communication. Nelson teaches a function which

allows customer to opt to not receive unwanted advertisement information. One of

ordinary skill in the art, presented with these teachings would have reasonable thought

to modify Munsil by allowing customers to not receive unwanted advertisement

information.

63.   It is unreasonable to conclude that a combination of Munsil and Nelson would have resulted in a customer receiving no communication at all, as customers need the billing information to pay their bill. The Examiner is not sure why a normal customer would do that if he or she needs to receive the bill. The Examiner is satisfied that a combination of the references discloses Applicant's invention as claimed.

64.   It is therefore the determination of the Examiner that the rejections with respect to claims 1, 7-11 and 18-27 in the previous Office Action are valid and applicable, and hence the rejections are maintained.

Conclusion

65.   Claims 1, 7-11 and 18-27 are rejected.

66.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7364. The examiner can normally be reached on M-F, 9-4 PM.

67.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
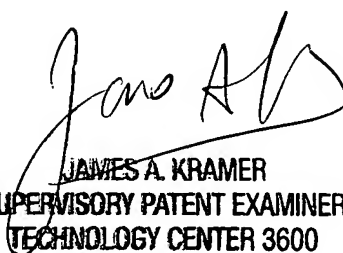
68.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

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HT

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